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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,903	01/06/2006	Alois Maier	NY-HUBR-1289 US (10600119)	7196
24972 7590 01/05/2007 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/563,903

Applicant(s)

MAIER ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/06</u> . | 6) <input type="checkbox"/> Other: ____ |

1. Claims 26-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 26 recites “preferably” prior to a claimed component. It is unclear if the component is required or not based on the language “preferably”.

B. The instant claim 26 recites “an average molar mass”. It is unclear what type of average is intended, e.g. number, weight, z, viscosity, etc.

C. The instant claims require “a laterally fluorine-modified, anionically stabilized polyurethane base dispersion (A) having preferably an ideally linearly segmented structure”. It is unclear how it can be “laterally fluorine-modified” and have “an ideally linearly segmented structure” both. This raises the issue of what is intended by “fluorine-modified” and “ideally linearly segmented structure”. The claims are unclear therefore.

D. It is unclear what is intended by “(paint)” after component D of claim 26.

E. Claim 26, iii recites “a molar mass” apparently of a polymeric species. It is unclear what type of polymeric average molecular weight is intended as the specification does not disclose a polydispersity of exactly one.

F. The instant claim 27 recites “(hydrophobically modified)”. It is unclear if the parentheses require the hydrophobic modification or if they are intended to indicate that this is optional as they often do in the art.

G. It is unclear what is intended by “an oxidatively drying alkyd resins” of claim 27.

H. It is unclear what is required by “(hydrocarbon spacers)” of the instant claim 28. Are hydrocarbon spacers required or only methylene groups or both.

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I. Regarding claim 50, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-27, and 31-51 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5039739 Padget et al..

Padget discloses an aqueous dispersion of addition polymer polymerized in the presence of a hydrophilic polyurethane which falls within the scope of that of the instant claims and using the instantly claimed initiator. It is expected that the polyurethane of the patentee necessarily and inherently possesses OH number, amine number, acid number and some type of molecular weight within the broad ranges of the instant claims. Due to the hydrophobic nature of the monomers disclosed and the hydrophilic nature of the polyurethane and the use of water, the patentee's polymerization will necessarily give the micelles required of the instant claims. The amounts disclosed by the patentee fall within the instantly claimed broad ranges. See the abstract; column 1, lines 5-68, particularly 46-68; column 2, lines 1-68, particularly 7 et seq.;

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column 3, lines 1-68, particularly 32-64; column 4, lines 1-68; column 5, lines 1-68; column 6, lines 1-68; column 7, lines 1-68; column 8, lines 1-68, particularly 44-68; column 9, lines 1-68, particularly 1-42 and 50-58; column 10, lines 1-68; and column 11, lines 1-60; column 12, lines 1-59. Since the polyurethane and monomer of the patentee are those of the instant claims and the amounts thereof, and the solids content of the instant claims is used, the particle size must be that of the instant claim 38. The coatings having the properties of column 9, lines 50-54 are easy cleaning and seal the substrate according to the instant claim 51.

5. Claims 26-27 and 31-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5039739 Padget et al..

Padget discloses an aqueous dispersion of addition polymer polymerized in the presence of a hydrophilic polyurethane which falls within the scope of that of the instant claims and using the instantly claimed initiator. It is expected that the polyurethane of the patentee necessarily and inherently possesses OH number, amine number, acid number and some type of molecular weight within the broad ranges of the instant claims. Due to the hydrophobic nature of the monomers disclosed and the hydrophilic nature of the polyurethane and the use of water, the patentee's polymerization will necessarily give the micelles required of the instant claims. The amounts disclosed by the patentee fall within the instantly claimed broad ranges. See the abstract; column 1, lines 5-68, particularly 46-68; column 2, lines 1-68, particularly 7 et seq.; column 3, lines 1-68, particularly 32-64; column 4, lines 1-68; column 5, lines 1-68; column 6, lines 1-68; column 7, lines 1-68; column 8, lines 1-68, particularly 44-68; column 9, lines 1-68, particularly 1-42 and 50-58; column 10, lines 1-68; and column 11, lines 1-60; column 12, lines 1-59. Since the polyurethane and monomer of the patentee are those of the instant claims and the

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amounts thereof, and the solids content of the instant claims is used, the particle size must be that of the instant claim 38. The coatings having the properties of column 9, lines 50-54 are easy cleaning and seal the substrate according to the instant claim 51.

It would at least be obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed method steps and parameters and the instantly claimed ingredients and amounts thereof to make the dispersions and coated substrates of the patentee because these parameters are encompassed by the patentee and would have been expected to give the coating properties disclosed by the patentee.

6. Claims 28-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art does not disclose the inventions of claims 28-30 nor provide rationale to modify the prior art considered into these inventions.

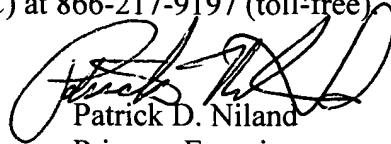
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

A handwritten signature in black ink, appearing to read "Patrick D. Niland", is written over the printed name.

Patrick D. Niland
Primary Examiner
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